



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,124	12/22/2000	Kazunori Arima	862.C2075	7920

5514 7590 06/22/2007
FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

USTARIS, JOSEPH G

ART UNIT	PAPER NUMBER
----------	--------------

2623

MAIL DATE	DELIVERY MODE
-----------	---------------

06/22/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/742,124	Applicant(s) ARIMA, KAZUNORI	
	Examiner Joseph G. Ustaris	Art Unit 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,19,21,23 and 51-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,19,21,23 and 51-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment dated April 02, 2007 in application 09/742,124.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 19, 21, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schaffa et al. (US005973685A) in view of Jones et al. (US005978013A).

Regarding claim 1, Schaffa et al. (Schaffa) discloses a digital broadcast receiving apparatus (See Fig. 1) comprising:

means for setting a digital broadcast program (See Fig. 2, user program selection 20) and a print reservation of partial content (See Fig. 2, user request print 25 of follow-up information (FUI)) which is provided in the program (See col. 2 lines 61-65) and can be displayed on a display when the program plays (the FUI can be displayed when the program is being viewed; See Fig. 2, Play FUI 27), in advance (wherein the user selection of the program and print of the FUI occurs in advance of viewing the program and printing the FUI);

means for receiving a digital broadcast of the program (See Fig. 1, tuner 14);
means for extracting the partial content (See Fig. 1, demultiplexer 9; col. 3 lines 54-56); and
printing mean for print-outputting the extracted partial content (See Fig. 1, printer 13; col. 3 lines 59-65).

However, Schaffa does not disclose a judging means for judging whether or not extracted partial content includes an information part print-output of which is not permitted, wherein the printing means print-output only that portion of the extracted partial content other than the information part when the judging means judge that the extracted partial content includes the information part.

Jones et al. (Jones) discloses a digital broadcast receiver that prints supplemental data. Jones discloses that the system has a judging means for judging whether or not extracted partial content (the plurality of coupons stored in 232 of Fig. 8) includes an information part (an individual coupon out of the coupons stored in 232) (See col. 14 lines 1-36) print-output of which is not permitted (the system determines if printing the coupon is allowed and does not permit printing if it has been printed before), wherein the printing means print output only that portion of the extracted partial content (the individual coupons that have not been printed before) other than the information part when the judging means judge that the extracted partial content includes the information part (the individual coupons that have been printed before) (See col. 14 line 37 – col. 15 line 5 and col. 16 lines 9-24). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the digital

broadcast receiving apparatus disclosed by Schaffa to include the judging means and print-output only that portion of the extracted partial content other than the information part when the judging means judge that the extracted partial content includes the information part, as taught by Jones, in order to provide a system that is able to safeguard the information (See col. 2 lines 34-38).

Claim 2 contains the limitations of claim 1 (wherein the digital broadcast receiving apparatus has an "output means" to transfer the print data to the printer (See Schaffa Fig. 1)) and is analyzed as previously discussed with respect to that claim.

Claim 19 contains the limitations of claim 1 (wherein the system performs the method) and is analyzed as previously discussed with respect to that claim.

Claim 21 contains the limitations of claim 1 (where inherently the system and system components are run by "computer programs" recorded on "computer-readable recording medium") and is analyzed as previously discussed with respect to that claim.

Claim 23 contains the limitations of claims 1 and 2 (where the system includes a server and head end or "transmitting apparatus" (See Schaffa Fig. 1)) and is analyzed as previously discussed with respect to those claims.

Claims 51-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schaffa et al. (US005973685A) in view of Jones et al. (US005978013A) as applied to claims 1, 2, 19, and 21 above, and further in view of Akerib (US006507362B1).

Regarding claim 51, Schaffa in view of Jones does not disclose that the system print-output a screen image of the external partial content to be displayed.

Akerib discloses an image generation device for printing out television images. Akerib discloses that the system print-output a screen image of the external partial content to be displayed (See col. 2 lines 57-63 and col. 4 line 49 – col. 5 line 8). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system disclosed Schaffa in view of Jones to have the system print-output a screen image of the external partial content to be displayed, as taught by Akerib, in order to expand the capabilities of the system thereby enabling the user to capture images seen on the television (See col. 2 lines 57-63).

Furthermore, Jones teaches that the printing means print-output a screen image other than the information part from the screen image when the judging means judge that the extracted partial content includes the information part as discussed above in claims 1, 2, 19, 21, and 23.

Claims 52-54 contains the limitations of claim 51 and is analyzed as previously discussed with respect to that claim.

Response to Arguments

3. Applicant's arguments with respect to claims 1, 2, 19, 21, 23, and 51-54 have been considered but are moot in view of the new ground(s) of rejection.

Furthermore, applicant argues with respect to claims 1, 2, 19, 21, and 23 that Jones does not prohibit the printing of just part of the content. However, reading the claims in the broadest sense, Jones does meet that limitation of the claims. Jones discloses that the system extracts partial content and stores the partial content (the

plurality of coupons stored in 232 of Fig. 8) that includes an information part (an individual coupon out of the coupons stored in 232) (See col. 14 lines 1-36). The system determines if printing the coupon is allowed and does not permit printing if it has been printed before (See col. 14 line 37 – col. 15 line 5 and col. 16 lines 9-24).

Applicant is reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The examiner suggests that applicant consider providing more details about how the user reserves a program and how the user makes a print reservation in the independent claims as supported by applicant's specification.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 2623

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph G. Ustaris whose telephone number is 571-272-7383. The examiner can normally be reached on M-F 7:30-5 PM; Alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher S. Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



JGU

June 14, 2007



SCOTT E. BELIVEAU
PRIMARY PATENT EXAMINER